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Paper No. 16

In re Application of
Mark Ashby *et al*
Application No. 09/843,496
Filed: April 25, 2001
Attorney Docket No. 034298-000092

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: DECISION ON PETITION
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This is a decision on the petition filed on February 6, 2004 by which petitioners request withdrawal of the examiner's requirement to restrict this application a single one of a plurality of patentably distinct inventions and to further elect a single species of the disclosed invention for prosecution in this application. The original requirement was promulgated on May 7, 2003, in paper No. 8 and made final on September 2, 2003, in paper No. 11. The petition is considered pursuant to 37 CFR 1.141 and 1.181, and no fee is required.

The petition is dismissed.

Initially, it is noted that in paper No. 8, the requirement as originally promulgated identified a total of four patentably distinct inventions. Two of these inventions were alleged by the examiner to be related as subcombinations useable together (MPEP § 806.05(d)), a third invention was said to be related to each of the two subcombination inventions as combination-subcombination (MPEP 806.05(c)) and the fourth invention was held to be a method that was distinct from each of the three inventions are method as process of use and the product being used (MPEP § 806.05(h)). In addition, the examiner determined that two patentably distinct species were disclosed and claimed in this application, namely the species Figure 4 which the examiner designated as "species A", and the species of Figure 8, designated by the examiner as "Species B."

Petitioners filed paper No. 9 on June 9, 2003, and in that reply, petitioners traversed the requirement to elect one of the four related but patentably distinct inventions. Petitioners' basis for traversing this requirement appears at page 5 of paper No. 9, and seems to be that the examiner did not demonstrate that the four patentably distinct inventions were also "independent inventions." Petitioners appear to have argued that the examiner failed to demonstrate that these inventions were both "independent and distinct", as required by 35 USC § 121. With respect to the election of species requirement, petitioners argued that the species were also related as distinct inventions, and that under the practice in MPEP § 806.04(b), the examiner was required to demonstrate that the species were patentably distinct under the "distinct inventions" test. It was argued that the species could not be independent inventions because they were interrelated.

Petitioners' traverse was not well taken. First, it has long been the practice to read the statutory language "independent and distinct" as meaning "independent or distinct". For a detailed explanation of why, see MPEP § 802.01.

Second, MPEP § 806.04(b) refers to the situation in which two species of a given device are also disclosed as useable together in a combination. The example given is two different species of clamp, each used at the same time in an overall combination. The species of Figure 4 and the species of Figure 8 are disclosed as being two variations of cutter, and are not disclosed as being useful together in the same combination. Hence, it was unnecessary for the examiner to apply MPEP 806.04(b) and rely upon distinct invention practice as well as species practice in order to support the election of species requirement that was promulgated. The examiner need only have determined that there was a least one claim limited to the species of Figure 4, and at least one claim limited to the species of Figure 8, and that the species were capable of supporting separate patents in order to justify requiring that petitioners elect a single species for prosecution in this application. See MPEP § 808.01.

With respect to the instant petition, there are two additional facts. First, petitioners have canceled claims 1-10, 13 and claims 17-26, leaving only claims 11, 12, 14-17 and newly added claim 27 directed to the combination of a cutting device generally having a base having an opening with cutting edges, an articulated flap having cutting edges corresponding to the cutting edges of the opening, and the base being mounted on a card which in turn supports a medical system for delivering foam material. Petitioners' characterization of claims 18-26 as being withdrawn is erroneous, see paper No. 9, page 3.


Second, petitioner is now arguing the Constitutionality of the "restriction requirement", that the restriction requirement must be based on claims in accordance with proper MPEP practice, and on a host of other reasons that did not form the basis for the original traverse. Nevertheless, these arguments will be answered, albeit, briefly.

Petitioners' Constitutional argument vis-a-vis the examiner's requirement to elect species is simply inaccurate with respect to what an election of species requirement is, and what the law is. It is not a "restriction requirement"; it is an election of species requirement. Petitioners' hypothetical example of an unconstitutional taking that would occur if one of petitioners' claims reads on both of the species precluding the filing of a divisional application is adequately addressed by 35 USC § 121, which precludes a rejection in a divisional application based upon double patenting of claims asserted in a divisional application that were subject to an election or restriction requirement in a parent application. In addition, 37 CFR 1.146 provides that an applicant will be permitted to claim a reasonable number of species in an application if a generic claim is found to be allowable. Petitioners have not been subjected to any sort of "taking" by reason of the examiner's requirements.

As to the arguments predicated on the proposition that restriction must be based upon claims, a species requirement is based upon embodiments. "*Claims are never species.*", MPEP § 806.04(e). (Emphasis in the original.) With respect to the argument in the penultimate paragraph of page 5 of the petition, it is again pointed out that with respect to the determination that the two species identified by the examiner are patentable over each other, the examiner has acted properly pursuant to MPEP § 808.01.

In summary, the petition presents no basis upon which to disturb the record as it currently exists, or upon which to hold that the examiner abused his discretion or acted in an arbitrary or capricious manner in first requiring restriction, then in requiring an election of species in addition to the restriction requirement, and then in making his requirements final. Therefore, the requested relief cannot presently be granted. Petitioners are entitled to file a request for reconsideration of this decision, which must be filed within two months of the date of this decision. See 37 CFR 1.181(f).

PETITION DISMISSED.


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